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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,261	07/13/2001	John MacAlister	1965-1-3	4870

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/905,261	MACALISTER ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 24-28 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19, 24-28 and 31-41 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Final Rejection Withdrawn

1. Upon further consideration and a review of the claimed subject matter, and in view of the newly found areas of search, the finality of the last Office Action is being withdrawn.

Prosecution is being reopened and a complete Office Action follows:

Rejections Withdrawn

2. claims 24-29 rejected under 35 USC 102(b) as being anticipated by Su in view of amendment filed on April 28, 2005.

3. Claims 1-10, 13-17, 19, 24—29 and 31-41 rejected under 35 USC 103(a) as being unpatentable over Su in view of the amendment.

4. Claims 11-12, 18 and 30 rejected under 35 USC 103(a) as being unpatentable over Su in view of GB: 1005155 in view of the amendment.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10, as stated, fails to further limit the independent claim because the plastic material does not further limit the plastic material of the independent claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 24- 28, 33-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkins (6038803).

Wilkins relates to a mount (D, E) consisting of a single layer of plastic such as PVC and having a first surface carrying an adhesive (col. 3, lines 50-60). The mount has first and second mutually opposite surfaces. The mount is shown to be flat and flexible (Figure-4). The first surface of the mount is releasably adhered to a backing material (F).

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The intended use phrases such as "for mounting paper to glass", "which adheres the mount to only...mountable arrangement", etc. have not been given any patentable weight as said phrases are not found to be of positive limitation.

The phrase "capable of" or "not capable of" has also not been given patentable weight because said phrase only requires the ability to so perform and does not constitute a limitation in any patentable sense *In re Hutchinson*, 69 USPQ 138.

Wilkins also teaches a method for securing a first material to a second material comprising releasably adhering a first surface of a mount to the first material (F), which is well known to be paper in the adhesive art, with an adhesive carried by the first surface, and securing the second surface to a second material (1) without adhesive.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-8, 10, 13, 16-19 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins.

Wilkins, as discussed above fails to teach that the mount arrangement comprises a plurality of mounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing the carrier to have

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thereon a plurality of mounts for facilitating handling and storage, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

The decorative display on the front of the mount would include a pigment material.

The release paper liner layer in the adhesive art is conventionally known to have silicone coating thereon for releasability.

11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins in view of Walker (GB: 2272682)

Wilkins, as discussed above, fails to teach that the sheet is in the form of a roll or a flat sheet. Walker discloses a polyvinyl chloride cling film in the form of a roll and from which pieces of the film can be removed. Therefore it would have been obvious to one having ordinary skill in the art to utilize Walker's teaching of using a roll for storing the cling film in the invention of Wilkins with the motivation for facilitating transportation and storability of the cling film product.

Further, with regard to the sheet being in a stack form, it would have been obvious to one having ordinary skill in the art to provide the sheet in a sheet or roll form because these two are art recognized equivalents for storing and transportation facilitation, and it would have been obvious to substitute stack for the roll.

12. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins in view of Mascarenhas (6171681).

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Wilkins, as discussed above, fails to teach that the PVC mount comprises plasticizer. Mascarenhas discloses that most cling films are PVC film which are highly flexible, particularly when they contain additives such as plasticizers. The film generally comprise about 50-55% of plasticizer (col. 2, lines 7-15). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Mascarenhas' teaching of using plasticizer added to the PVC cling film in the invention of Wilkins with the motivation to render said PVC films flexible.

13. Claims 14-15 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins.

Wilkins, as discussed above, relates to a film having a certain thickness, but fails to teach that the thickness is up to 2 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing its PVC cling film to have thickness of less than 2mm for flexibility and conformability, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Similarly, the film of Wilkins has a certain surface area and that the dimensions can be varied, but fails to teach that the area is 100 to 900 sqmm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wilkins by providing it PVC film to have a surface area of 100 to 900 sqmm for providing

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optimum coverage by the covering, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

14. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach the mount structure as claimed and wherein the mount is transparent.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
May 23, 2005.